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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,705	09/15/2000	ERNEST YIU CHEONG WAN	169.1826	1732

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EXAMINER	
SWEARINGEN, JEFFREY R	
ART UNIT	**PAPER NUMBER**
2145	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/662,705	WAN, ERNEST YIU CHEONG	
	Examiner	Art Unit	
	Jeffrey R. Swearingen	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-31,33-40 and 42-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-31,33-40 and 42-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/19/2007 have been fully considered but they are not persuasive.

2. Applicant has overcome the rejection under 35 U.S.C. 101.

3. Applicant argued the specification contained a description of "monolithic blocks of information" that "at least provide[d] a context, which would be readily understood by one skilled in the art, for the term 'monolithic AV content'". At least providing a context to one of ordinary skill in the art is not providing a definition to one of ordinary skill in the art. One of ordinary skill in the art is unable to comprehend what Applicant meant by "monolithic AV content". No supposed amount of context could provide a possible definition for this unknown term in the art, based upon searches of both patents and non-patent literature which both returned no definition of monolithic data, much less any definition which would be found reasonable to one of ordinary skill in the art. Multiple senior patent examiners have been consulted within the Office. Assuming a patent examiner possesses skill above and beyond ordinary skill in the art, and no patent examiners know how to read this term, then it is inherent that one possessing ordinary skill would not comprehend this terminology. Since one of ordinary skill in the art is unclear what Applicant means by "monolithic AV content", one of ordinary skill in the art cannot enable this invention.

4. Failing the presentation of a reasonable definition of "monolithic AV content" by Applicant, the broadest reasonable interpretation of this term is read to be data. Schmeidler meets the limitations of the claims given this best possible interpretation. It is impossible to clearly ascertain argue Applicant's further arguments concerning Schmeidler and "monolithic AV content", since it is impossible to understand Applicant's meaning of "monolithic AV content" given the lack of detail in the originally filed specification.

5. Applicant has previously withdrawn claims 32, 41, and 50, as belonging to a non-elected group. "In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an **allowable claim**." (Emphasis added) The pending claims are not in condition for allowance, making rejoinder under MPEP 821.04 improper.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 24-31, 33-40, and 42-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8. MPEP 2164 gives the grounds of the Test of Enablement. The specification must "describe the invention in such terms that one skilled in the art can make and use the claimed invention". "The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention."

9. MPEP 2164.01(a) described the factors to determine whether there is sufficient evidence to support that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include, but are not limited to:

a. The breadth of the claims;

b. The nature of the invention;

c. The state of the prior art;

d. The level of one of ordinary skill;

e. The level of predictability in the art;

f. The amount of direction provided by the inventor;

g. The existence of working examples; and

h. The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

10. MPEP 2164.01(b) states "as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.

11. MPEP 2164.01(c) states "if a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied.

12. The claims and originally filed specification are egregiously deficient in terms of the enablement requirements put forward by 35 U.S.C. 112, first paragraph.

13. Claims 24-31, 33-40, and 42-49 deal with "monolithic AV content". Applicant admitted this in the response of June 26, 2006. The originally filed specification referred in passing to "monolithic AV content" twice without defining what "monolithic AV content" encompassed.

14. The level of one of ordinary skill in the art is an artisan with a Bachelor's degree in electrical or computer engineering and 2-3 years of industry experience.

15. One of ordinary skill in the art would be unaware of what "monolithic AV content" consisted of. A search of the prior art failed to disclose what one of ordinary skill in the art could construe "monolithic AV content" to mean.

16. The lack of information concerning "monolithic AV content" supports the analysis of the factors that the disclosure would require undue experimentation. The claims are extremely broad, even with the usage of the term "monolithic AV content". The nature of the invention is unclear to one of ordinary skill in the art.

17. Applicant stated that audio-visual data "typically manifest(s) themselves as monolithic blocks of information". Originally filed specification, page 2, lines 3-5. A search of the prior art failed to produce evidence agreeing with Applicant's assertion, as the prior art never referred to the use of monolithic AV data.

18. One of ordinary skill in the art using the level of the artisan previously presented would be unable to ascertain how to implement the invention as currently claimed with the current specification. One of ordinary skill in the art is unaware of "monolithic AV content".

19. The inventor provided inadequate direction to teach one of ordinary skill in the art the use and implementation of "monolithic AV content". Therefore, one of ordinary skill in the art would necessarily suffer the burden of undue experimentation in implementing this invention.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

21. Claims 24-31, 33-40, and 42-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmeidler et al. (US 6,763,370 B1).

22. In regard to claims 24, 33, and 42, Schmeidler disclosed:

determining a network address for locating the monolithic AV content; (column 13, lines 49-53)

generating a fragment identifier for at least one fragment corresponding to at least one of said levels of data of said monolithic AV content, using the logical model; (column 14, lines 1-38) *and*

combining the network address and the fragment identifier to form a URI reference, being an address for locating the AV fragment (column 14, lines 24-26).

23. In regard to claims 25, 34, and 43, Schmeidler disclosed:

providing an addressing scheme for addressing said at least one fragment to the levels of detail of said logical model. (column 2, lines 47-65; column 13, lines 40-67)

24. In regard to claims 26, 35, and 44, Schmeidler disclosed:

the addressing scheme for addressing said at least one fragment includes at least one of a time axis, a time function, a region axis, and a region function. (column 13, lines 50-67. The region axis and region function is the location on the server of the title. Time axis and function is provided in column 4, lines 7-22)

25. In regard to claims 27, 36, and 45, Schmeidler disclosed:

the fragment identifier is determined based on a hierarchical representation of the monolithic AV content generated by applying the logical model. (column 14, lines 1-38)

26. In regard to claims 28, 37, and 46, Schmeidler disclosed:

the monolithic AV content is a single file in a file system supporting Audio/Video content. (column 1, lines 35-55; column 2, lines 35-56)

27. In regard to claims 29, 38, and 47, Schmeidler disclosed:

the monolithic AV content is one from the group consisting of a Digital Versatile Disk (DVD), Compact Disk Read Only Memory (CD ROM), Audio Compact Disk (CD), Video Tape and Audio Tape. (column 1, line 64 – column 2, line 3)

28. In regard to claims 30, 39, and 48, Schmeidler disclosed:

said addressing scheme is Xpath based. (column 17, lines 37-51; column 18, lines 1-18)

29. In regard to claims 31, 40, and 49, Schmeidler disclosed:

the addressing scheme provides a syntax for addressing one or more AV fragments in the fragment identifier. (column 13, lines 53-63)

Conclusion

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 2145